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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,126	04/02/2004	Miles Libbey	08226/1200320-US1	1506
38880	7590	02/03/2009		
Yahoo! Inc. c/o DARBY & DARBY P.C. P.O. BOX 770 Church Street Station NEW YORK, NY 10008-0770			EXAMINER NGUYEN, DUSTIN	
			ART UNIT 2454	PAPER NUMBER
			MAIL DATE 02/03/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/817,126	Applicant(s) LIBBEY ET AL.	
	Examiner DUSTIN NGUYEN	Art Unit 2454	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-30 are presented for examination.

Response to Arguments

2. Applicant's arguments filed 11/07/2008 have been fully considered but they are not persuasive.

3. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Logan and Rhodes in order to provide a system for handling delivery of e-mail to lessen the impact of unsolicited bulk e-mail and provide an active disincentive to bulk e-mail practice [Rhodes, paragraph 0004].

4. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so

Art Unit: 2454

long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- A. The claim language in the following claims is being considered as indefinite:

- I. As per claims 1, 12, 21, and 30, the claim limitation is not clearly explained whether the client system or the message system, i.e. the sender server or the sender MTA, performs the disablement function to prevent composed message from reaching receiver system. Applicant's remark indicates that page 3, lines 18-25, and page 10, lines 16-18 of the specification provide support for this limitation, but Examiner does not find such explanation in the indicated section.

Claim Rejections - 35 USC § 103

Art Unit: 2454

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3, 5, 7, 9-14, 16, 18-23, 25, and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al. [US Patent No 7,380,126], in view of Rhodes [US Patent Application No 2003/0220978], and further in view of Bandini et al. [US Patent Application No 2002/0169954].

9. As per claim 1, Logan discloses the invention as claimed including a method for managing outbound message usage [i.e. controlling the transmission of email messages] [Figure 1; and Abstract], comprising:

determining a count of each recipient for each outbound message associated with a client [i.e. count recipients] [115, Figure 1; col 3, lines 44-50; and col 4, lines 12-21]; if the count of each recipient is at least equal to a limit over at least one period of time [i.e. exceeds a threshold] [117, Figure 1; col 3, lines 49-51; and col 4, lines 12-21], providing a visual challenge to the client [i.e. notify sender with warning message] [118, Figure 1; and col 3, lines 51-57], wherein the client's outbound message usage includes a message composed by the client before the providing of the visual challenge to the client [i.e. compose email message] [111, Figure 1; col 3, lines 10-21; and col 4, lines 34-37].

Logan does not specifically disclose

Art Unit: 2454

if the provided visual challenge is unresolved, disabling the client's outbound message usage until the visual challenge is resolved.

Rhodes discloses

if the provided visual challenge is unresolved, disabling the client's outbound message usage until the visual challenge is resolved [i.e. interrupt or postpone delivery of email message until the message sender passes a user-configurable challenge] [Abstract; paragraphs 0014 and 0026].

Logan and Rhodes do not specifically disclose wherein disabling the client's outbound message usage occurs prior to sending the compose message for the client over a network from a messaging system employed to originate each outbound message associated with the client, and wherein disabling the client's outbound message usage further includes disabling an ability of the client to send the composed message to the messaging system for sending to each recipient.

Bandini discloses wherein disabling the client's outbound message usage occurs prior to sending the compose message for the client over a network from a messaging system employed to originate each outbound message associated with the client, and wherein disabling the client's outbound message usage further includes disabling an ability of the client to send the composed message to the messaging system for sending to each recipient [i.e. e-mail firewall returns e-mail to sender or drop without further forwarding it to next destination] [711, 712, Figure 7; and paragraphs 0044, 0050 and 0064].

Art Unit: 2454

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching Bandini with Logan and Rhodes in order to reduce network traffic and communication overhead.

10. As per claim 2, Logan discloses if at least one outbound message associated with the client is indicative of spam for at least one recipient, providing the visual challenge to the client [i.e. spam email] [col 1, lines 47-col 2, lines 17; and col 4, lines 12-21].

11. As per claim 3, Rhodes discloses wherein the visual challenge further comprises an auditory challenge, and wherein until at least one of the visual challenge and the auditory challenge is resolved, disabling the client's outbound message usage [paragraphs 0026, 0043, and 0044].

12. As per claim 5, Rhodes discloses wherein the visual challenge further comprises an auditory challenge, and wherein the auditory challenge includes at least one sound clip that is filtered to distort the playing of the sound clip for the auditory challenge [paragraphs 0026, 0044; and claim 14].

13. As per claim 7, Rhodes discloses if the provided visual challenge is unresolved over a predetermined period of time, disabling the client's outbound message usage [i.e. wait for satisfactory response] [paragraphs 0034, 0037 and 0061].

Art Unit: 2454

14. As per claim 9, Logan discloses wherein a type of the message includes at least one type of email, blog, message board, Short Message Service (SMS), Multi-Media Message Service (MMS), and instant messaging (IM) [Abstract; and col 1, lines 56-65].

15. As per claim 10, Rhodes discloses if the client's outbound message usage is disabled, providing instructions for an out of band communication by the client for re-enabling the client's outbound message usage [i.e. generate challenge until receive satisfactory response] [paragraphs 0034 and 0037].

16. As per claim 11, Logan discloses employing a recipient count statement to determine the count for each recipient for each outbound message associated with the client, wherein the recipient count statement determines at least one of a current hour recipient count, a current daily recipient count, and a total recipient count [i.e. an indication of the number of other recipients] [col 1, lines 59-61; and col 3, lines 64-67].

17. As per claims 12-14, 16, and 18-20, they are rejected for similar reasons as stated above in claims 1-3, 7, 9-11.

18. As per claims 21-23, 25, 27-29, they are rejected for similar reasons as stated above in claims 1-3, 7, 9-11.

19. As per claim 30, it is rejected for similar reasons as stated above in claim 1.

20. Claims 6, 8, 15, 17, 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al. [US Patent No 7,380,126], in view of Rhodes [US Patent Application No 2003/0220978], Bandini et al. [US Patent Application No 2002/0169954], and further in view of Wilson [US Patent Application No 2004/0015554].

21. As per claim 6, Logan, Rhodes and Bandini do not specifically disclose determining another count for each attempt to resolve the visual challenge; and if the other count for each attempt is at least equal to another limit, disabling the client's outbound message usage. Wilson discloses determining another count for each attempt to resolve the visual challenge; and if the other count for each attempt is at least equal to another limit, disabling the client's outbound message usage [i.e. allow another try if response is not correct] [Figure 2; and paragraphs 0063 and 0065]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Logan, Rhodes, Bandini and Wilson because the teaching of challenge-response in Wilson would provide a mechanism for eliminating or at least greatly reducing the successful transmission of unwanted e-mail while still making it easy and convenient to receive wanted e-mail [Wilson, paragraphs 0002 and 0022].

22. As per claim 8, Wilson discloses if the visual challenge is resolved, resetting the count for each recipient of each outbound message associated with the client [paragraphs 0063 and 0072].

23. As per claims 15 and 17, they are rejected for similar reasons as stated above in claims 6 and 8.

24. As per claims 24 and 26, they are rejected for similar reasons as stated above in claims 6 and 8.

25. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al. [US Patent No 7,380,126], in view of Rhodes [US Patent Application No 2003/0220978], Bandini et al. [US Patent Application No 2002/0169954], and further in view of Burrows et al. [US Patent No 7,149,801].

26. As per claim 4, Logan, Rhodes, Bandini do not specifically disclose wherein the visual challenge includes at least one Captcha test. Burrows discloses wherein the visual challenge includes at least one Captcha test [col 3, lines 19-25; and col 25, lines 36-46]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Logan, Rhodes and Burrows because the teaching of Burrows would enable to create puzzles that can be solved only by humans, for the purpose of telling humans and computers apart over a network [Burrows, col 3, lines 19-21].

Art Unit: 2454

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (571) 272-3971. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached at (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2454

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Dustin Nguyen/
Primary Examiner, Art Unit 2454